

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

CHATTERJEE, Deb K.

Appl. No.: 09/229,173

Filed: January 13, 1999

For: **Cloned DNA Polymerases from  
*Thermotoga Maritima* and Mutants  
Thereof**

Confirmation No.: 7438

Art Unit: 1652

Examiner: Hutson, Richard G.

Atty. Docket: 0942.2800008/RWE/RCM/GLL

**Seventh Supplemental Information Disclosure Statement**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98. The numbering on this Seventh Supplemental Information Disclosure Statement is a continuation of the numbering in Applicant's Sixth Supplemental Information Disclosure Statement filed on April 7, 2004 in connection with the above-captioned application.

Applicant would like to bring to the Examiner's attention cited Office Actions (Documents AT17-AT20) from the following copending applications which are directed to related technical matter:

U.S. Patent Application No. 08/526,759, filed December 26, 1995; and

U.S. Patent Application No. 09/558,421, filed April 26, 2000;

The identification of these Office Actions is not to be construed as a waiver of secrecy as to the corresponding applications now or upon issuance of the present

application as a patent. The Examiner is respectfully requested to consider the cited Office Actions during prosecution of these applications.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicant has listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicant reserves the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

Applicant has checked the appropriate boxes below.

- ☐ 1. Statement under 37 C.F.R. 1.704(d). Each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart application and this communication was not received by any individual designated in 37 C.F.R. § 1.56(c) more than thirty days prior to the filing of this information disclosure statement.
- ☒ 2. Filing under 37 C.F.R. § 1.97(b). This Information Disclosure Statement is being filed within three months of the date of filing of a national application other than

a continued prosecution application (CPA), OR within three months of the date of entry of the national stage as set forth in 37 C.F.R. § 1.491 in an international application, OR before the mailing date of a first Office Action on the merits OR before the mailing of a first Office Action after the filing of a request for continued examination (RCE) under 37 C.F.R. § 1.114. No statement or fee is required.

- ☐ 3. Filing under 37 C.F.R. § 1.97(c). This Information Disclosure Statement is being filed more than three months after the U.S. filing date AND after the mailing date of the first Office Action on the merits, but before the mailing date of a Final Rejection, or Notice of Allowance, or an action that otherwise closes prosecution in the application.
- ☐ a. Statement under 37 C.F.R. § 1.97(e)(1). I hereby state that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).
- ☐ b. Statement under 37 C.F.R. § 1.97(e)(2). I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).
- ☐ c. Attached is our PTO-2038 Credit Card Payment Form in the amount of \$ \_\_\_\_\_ in payment of the fee under 37 C.F.R. § 1.17(p).

- ☐ 4. Filing under 37 C.F.R. § 1.97(d) This Information Disclosure Statement is being filed more than three months after the U.S. filing date and after the mailing date of a Final Rejection or Notice of Allowance, but before payment of the Issue Fee. Enclosed find our PTO-2038 Credit Card Payment Form in the amount of \$\_\_\_\_\_ in payment of the fee under 37 C.F.R. § 1.17(p); in addition:
- ☐ a. Statement under 37 C.F.R. § 1.97(e)(1). I hereby state that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).
- ☐ b. Statement under 37 C.F.R. § 1.97(e)(2). I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).
- ☐ 5. The document(s) was/were cited in a search report by a foreign patent office in a counterpart foreign application. Submission of an English language version of the search report that indicates the degree of relevance found by the foreign office is provided in satisfaction of the requirement for a concise explanation of relevance. 1138 OG 37, 38.
- ☐ 6. A concise explanation of the relevance of the non-English language document(s) appears below:
- ☒ 7. Copies of the cited documents are submitted herewith.

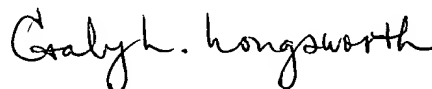
- ☐ 8. Copies of the documents were cited by or submitted to the Office in an IDS that complies with 37 C.F.R. § 1.98(a)-(c) in Application No. \_\_\_\_\_, filed \_\_\_\_\_, which is relied upon for an earlier filing date under 35 U.S.C. § 120. Thus, copies of these documents are not attached. 37 C.F.R. § 1.98(d).
- ☐ 9. No copies of U.S. patents and patent application publications cited on the attached Form PTO-1449 are submitted in accordance with 1276 OG 55 because this application was filed after June 30, 2003.
- ☐ 10. It is expected that the examiner will review the prosecution and cited art in the parent applications in accordance with MPEP 2001.06(b), and indicate in the next communication from the office that the art cited in the earlier prosecution history has been reviewed in connection with the present application.

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO-1449, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Gaby L. Longsworth  
Attorney for Applicant  
Registration No. 47, 756

Date: May 4, 2004

1100 New York Avenue, N.W.  
Washington, D.C. 20005-3934  
(202) 371-2600



Robert Greene Sterne  
Edward J. Kessler  
Jorge A. Goldstein  
David K.S. Cornwell  
Robert W. Esmond  
Tracy-Gene G. Durkin  
Michele A. Cimbala  
Michael B. Ray  
Robert E. Sokohl  
Eric K. Steffe  
Michael Q. Lee  
Steven R. Ludwig  
John M. Covert  
Linda E. Alcorn  
Robert C. Millonig  
Lawrence B. Bugaisky  
Donald J. Featherstone  
Michael V. Messinger

Judith U. Kim  
Timothy J. Shea, Jr.  
Patrick E. Garrett  
Heidi L. Kraus  
Edward W. Yee  
Albert L. Ferro\*  
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Elizabeth J. Haanes  
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LuAnne M. DeSantis  
John J. Figueroa  
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Tiera S. Coston\*  
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Michael D. Specht  
Jessica L. Parezo  
Timothy A. Doyle\*  
Cynthia M. Bouchez  
Nicole D. Dretar\*  
Ted J. Ebersole  
**Registered Patent Agents\***  
Karen R. Markowicz  
Nancy J. Leith  
Helene C. Carlson  
Gaby L. Longworth  
Matthew J. Dowd  
Aaron L. Schwartz  
Mary B. Tung  
Katrina Y. Pei Quach  
Bryan L. Skelton  
Robert A. Schwartzman

Teresa A. Colella  
Jeffrey S. Lundgren  
Victoria S. Rutherford  
Eric D. Hayes  
Michelle K. Holoubek  
Robert H. DeSels  
Simon J. Elliott  
Julie A. Helder  
Mita Mukerjee  
Scott M. Woodhouse

**Of Counsel**  
Kenneth C. Bass III  
Evan R. Smith  
Marvin C. Guthrie  
\*Admitted only in Maryland  
\*Admitted only in Virginia  
\*Practice Limited to Federal Agencies

May 4, 2004

**WRITER'S DIRECT NUMBER:**  
(202) 772-8824  
**INTERNET ADDRESS:**  
GLONGS@SKGF.COM

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**Art Unit 1652**

Re: U.S. Utility Patent Application  
Application No. 09/229,173; Filed: January 13, 1999  
For: **Cloned DNA Polymerases From *Thermotoga maritima* and Mutants Thereof**  
Inventor: Deb K. CHATTERJEE  
Our Ref: 0942.2800008/RCM/GLL

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Seventh Supplemental Information Disclosure Statement;
2. Form PTO-1449 citing ten documents;
3. A copy of the ten cited documents; and
4. One return postcard.

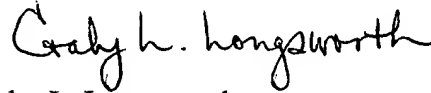
It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Commissioner for Patents  
May 4, 2004  
Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink that reads "Gaby L. Longworth". The signature is written in a cursive, flowing style.

Gaby L. Longworth  
Attorney for Applicant  
Registration No. 47,756

RWE/RCM/GLL/eaf  
Enclosures

258219v1



FORM PTO-1449

ATTY. DOCKET NO.  
0942.2800008/RWE/RCM/GLLAPPLICATION NO.  
09/229,173SEVENTH SUPPLEMENTAL INFORMATION DISCLOSURE  
STATEMENTFIRST NAMED INVENTOR  
CHATTERJEE, Deb K.FILING DATE  
January 13, 1999ART UNIT  
1652

## U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA						
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						

## FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

## OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

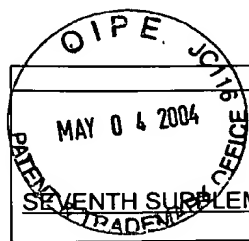
	AR		
	AS		
	AT	17	Copy of August 9, 1996, Office Action for U.S. Patent Application No. 08/576,759, Chatterjee, D.K., filed December 21, 1995

EXAMINER

DATE CONSIDERED

**EXAMINER:** Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.





FORM PTO-1449

ATTY. DOCKET NO.  
0942.2800008/RWE/RCM/GLL

APPLICATION NO.  
09/229,173

FIRST NAMED INVENTOR  
CHATTERJEE, Deb K.

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	AK						

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	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

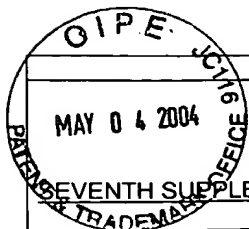
### OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

AR	18	Copy of January 28, 1997, Office Action for U.S. Patent Application No. 08/576,759, Chatterjee, D.K., filed December 21, 1995
AS	18	Copy of July 9, 1999, Office Action for U.S. Patent Application No. 08/576,759, Chatterjee, D.K., filed December 21, 1995
AT	18	Copy of October 26, 1999, Office Action for U.S. Patent Application No. 08/576,759, Chatterjee, D.K., filed December 21, 1995

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APPLICATION NO.  
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FIRST NAMED INVENTOR  
CHATTERJEE, Deb K.

FILING DATE  
January 13, 1999

ART UNIT  
1652

# EVENTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

## U.S. PATENT DOCUMENTS

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	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

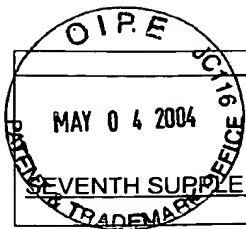
## OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>19</u>	Copy of September 20, 2000, Office Action for U.S. Patent Application No. 09/558,421, Chatterjee, D.K., filed April 26, 2000
	AS	<u>19</u>	Copy of June 4, 2001, Office Action for U.S. Patent Application No. 09/558,421, Chatterjee, D.K., filed April 26, 2000
	AT	<u>19</u>	Copy of June 4, 2002, Office Action for U.S. Patent Application No. 09/558,421, Chatterjee, D.K., filed April 26, 2000

EXAMINER

DATE CONSIDERED

**EXAMINER:** Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.



MAY 04 2004

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09/229,173FIRST NAMED INVENTOR  
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1652SEVENTH SUPPLEMENTAL INFORMATION DISCLOSURE  
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	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

## OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	20	Copy of July 26, 2002, Office Action for U.S. Patent Application No. 09/558,421, Chatterjee, D.K., filed April 26, 2000
	AS	20	Copy of April 22, 2003, Office Action for U.S. Patent Application No. 09/558,421, Chatterjee, D.K., filed April 26, 2000
	AT	20	Copy of February 9, 2004, Office Action for U.S. Patent Application No. 09/558,421, Chatterjee, D.K., filed April 26, 2000

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